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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,106	03/16/2004	Bran Ferren	1103-007-001-000000	3221
71/484	7/5/0	08/20/2008		
IV - SUITER SWANTZ PC LLO 14301 FNB PARKWAY , SUITE 220 OMAHA, NE 68154			EXAMINER FRANKLIN, JAMARA ALZAIDA	
			ART UNIT 2876	PAPER NUMBER
			MAIL DATE 08/20/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,106

Applicant(s)

FERREN ET AL.

Examiner

JAMARA A. FRANKLIN

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgment is made of the amendment filed on May 12, 2008. Claims 1-48 are currently pending.

Claim Objections

1. Claims 13-21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The method of claims 13-21 drawn to a method for identifying an item fail to further limit the apparatus of claim 1 drawn to the item.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-22, 27-41, 43, and 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by McElhatton et al. (US 6,701,652) hereinafter referred to as ‘McElhatton’).

McElhatton teaches
an item comprising

an outer part including at least one outer material (substrate 22) that is substantially opaque to visible light; and

an identifier including at least one three-dimensional configuration (configuration of inks areas 46 and gap regions 48) corresponding to the identifier, the at least one three-dimensional configuration being embedded within the at least one outer material and including at least one of

a substantially empty cavity in the at least one outer material, or

at least one identifying material filling at least part of a cavity in the at least one outer material and wherein the at least one outer material in which the at least one identifying material fills at least part of the cavity is substantially opaque to visible light (col. 2, lines 27-30 and col. 3, lines 30-34);

a method of making an item, the method comprising:

forming at least one portion of the item form at least one structural material; and

integrally with said forming the at least one portion, enclosing within the at least one structural material identifying information that identifies the item, the identifying information including at least one three-dimensional configuration including at least one of

a void substantially shaped as the at least one three-dimensional configuration, the void defined by the at least one structural material, or

an identifying material shaped as at least part of the at least one three-dimensional configuration, wherein the at least one structural material is substantially opaque to visible light;

the item and method wherein the identifier identifies the item uniquely;

the item and method wherein the at least one three-dimensional configuration is directly accessible by physically separating the at least one portion into at least two parts;

the item wherein the at least one three-dimensional configuration is directly accessible only by disassembling the item;

the item wherein the at least one identifying material emits identifying electromagnetic radiation when irradiated with specified electromagnetic radiation;

the item wherein the identifying material comprises a security tag;

the method wherein the void is substantially empty;

the method wherein the identifying information identifies the item uniquely by including a serial number that is unique to the item; and

the method wherein the structural material is substantially opaque to visible light.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(e) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 24-26, 42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over McElhatton in view of Waldron et al. (US 5,296,691) (hereinafter referred to as 'Waldron').

The teachings of McElhatton have been discussed above.

McElhatton lacks the teaching of identifying the item as a member of a set of similar items.

Waldron teaches a method of identifying an item as a member of a set of similar items (col. 1, lines 12-13).

One of ordinary skill in the art would have readily recognized that providing the McElhatton invention with the identification of an item as a member of a set of similar items would have been beneficial for allowing a set of similar items to be recognized amongst another set of similar items thereby helping to control and manage inventory. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of McElhatton with the aforementioned teaching of Waldron.

Response to Arguments

7. Applicant's arguments with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cook (US 4,826,713) teaches a trim strip with three-dimensional markings.

True (US 2007/0148599) teaches multiple step printing methods for microbarcodes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMARA A. FRANKLIN whose telephone number is (571)272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamara A. Franklin/
Primary Examiner, Art Unit 2876

JAF
August 17, 2008

